

Michael R. Graif (mrgraif@mintz.com)
John A. Bauer (jbauer@mintz.com)
Mintz, Levin, Cohn, Glovsky and Popeo, P.C.
666 Third Avenue
New York, New York 10017
(212) 692-6287
Attorneys for Sabatino North America LLC,
Sabatino Truffles New York, LLC and Ethoa, LLC

ECF CASE

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

SABATINO NORTH AMERICA, LLC,)	
)	
and)	
)	
SABATINO TRUFFLES NEW YORK,)	
LLC)	
)	
and)	
)	
ETHOA, LLC)	
)	
Plaintiffs,)	19. Civ. _____
)	
-against-)	
)	
TARTUFI JIMMY S.r.l ,)	
)	
and)	
)	
TITA ITALIAN IMPORT AND EXPORT)	
LLC)	
)	
Defendants.)	

COMPLAINT AND DEMAND FOR JURY TRIAL

Sabatino North America, LLC (“Sabatino NA”), Sabatino Truffles New York, LLC (“Sabatino Truffles”) and Ethoa, LLC (“Ethoa”) (collectively “Sabatino”), by its attorneys, Mintz Levin, for its complaint against Tartufi Jimmy S.r.l. (“Tartufi Jimmy”) and Tita Italian Import & Export LLC (“Tita Italian”) (collectively “Defendants”), allege as follows:

INTRODUCTION

1. This is an action for trade mark infringement, trade dress infringement, deceptive acts and practices, unfair competition, and related claims against Tartufi Jimmy's Truffle Spice product ("Truffle Spice"). Tartufi Jimmy, an Italian Company, introduced Truffle Spice in the market in 2018. In 2019, Tartufi Jimmy radically changed its packaging by designing it to deliberately mimic the unique elements of the distinctive trade dress of Sabatino's highly successful TRUFFLE ZEST truffle powder seasoning product.

2. On information and belief, Tita Italian Import & Export LLC ("Tita Italian") is a U.S. importer and retailer who markets and sells Truffle Spice through its website www.titaitalia.com and at its physical location Tita Italia Wine & Delicatessen located at 1408 NW 23rd Street, Miami, FL 33142. In addition to also infringing Sabatino's trade dress by marketing and selling Truffle Spice, Tita Italian is using the hashtag "#trufflezest" on its Facebook page on which it displays Tartufi Jimmy's Truffle Spice. As a result, the consuming public is likely to be confused into believing that there is a connection between Tita Italian or Tartufi Jimmy on the one hand, and Sabatino on the other.

3. Because Truffle Spice's copycat trade dress and Tita Italian's use of the hashtag #trufflezest to market sell Truffle Spice inevitably confuse consumers, Sabatino is seeking the relief requested herein.

THE PARTIES

4. Sabatino North America, LLC is a limited liability company organized and existing under the laws of the State of New York with its principal place of business at 135 Front Avenue, West Haven, Connecticut. Sabatino North America, LLC markets and sells TRUFFLE ZEST truffle powder seasoning.

5. Sabatino Truffles New York, LLC is a limited liability company existing under the laws of the State of New York, with its principal place of business as 400 East 54th Street, New York, New York. Sabatino Truffles New York, LLC operates a retail store at that location, where it markets and sells TRUFFLE ZEST truffle powder seasoning.

6. Ethoa, LLC is a limited liability company organized and existing under the laws of Delaware with its principal place of business at 135 Front Avenue, West Haven, Connecticut. Ethos, LLC owns U.S. Trademark Registration No. 5,163,009 on the Supplemental Register dated March 14, 2017 for TRUFFLE ZEST for “Truffle powder seasoning”.

7. On information and belief, Tartufi Jimmy S.r.l is a corporation organized and existing under the laws of Italy with its principal place of business at Via dei Tigli, 16 06026 Pietralunga (Pg) – Italy.

8. On information and belief, Tita Italian Import & Export LLC is a limited liability company formed under the law of the State of Florida with its principal place of business at 1408 NW 23rd Street, Miami, FL 33142.

JURISDICTION AND VENUE

9. This Court has original jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338 and has supplemental jurisdiction pursuant to 28 U.S.C. §§ 137(a).

10. This Court has personal jurisdiction over Defendants pursuant to N.Y. Civ. Prac. L. & R. § 302(a). Both Defendants Tartufi Jimmy and Tita Italian are regularly soliciting business and have transacted business in the State of New York and in this District through its sale of its products on a nationwide basis including sales throughout the State of New York.

11. Venue is proper in this district as against Defendants Tartufi Jimmy and Tita Italian pursuant to 28 U.S.C. § 1391(b) because Defendants Tartufi Jimmy and Tita Italian conduct business in this district, and a substantial part of the events giving rise to the claims in this action occurred in this judicial district, and as against Defendant Tartufi Jimmy pursuant to 28 U.S.C. § 1391(c) because Tartufi Jimmy is a foreign corporation.

SABATINO'S TRADE DRESS FOR TRUFFLE ZEST

12. Sabatino is a market leader for truffle based products, which it has been selling since 1999. Sabatino has sold over \$150,000,000 of such products, of which approximately \$3,700,000 is attributable to its TRUFFLE ZEST truffle powder seasoning from 2015 to the present.

13. Sabatino designed a unique and distinctive trade dress for its truffle based seasonings – of which TRUFFLE ZEST truffle powder seasoning is one. They all share a common appearance of a white label featuring a colorful circular panel and a half-view of a truffle on the bottom of the label.

14. In particular, TRUFFLE ZEST truffle powder seasoning has a unique and distinctive trade dress that prominently features the key elements of (a) a white label with negative lettering on a gold background, (b) a gold circle with the same negative lettering on a gold background, (c) the bottom of the label prominently featuring a large half-open truffle with black skin among other open truffles, and (d) a cylindrically shaped spice bottle.



SABATINO'S ADVERTISING AND MARKETING OF TRUFFLE ZEST

15. TRUFFLE ZEST truffle powder seasoning was initially marketed in September 2015.

16. For the past four years, Sabatino has been the market share leader in the truffle seasoning category. Over this period, due to the quality of TRUFFLE ZEST TRUFFLE POWDER and Sabatino's extensive and innovative marketing efforts, the growth of TRUFFLE ZEST truffle powder seasoning has been exponential.

17. TRUFFLE ZEST truffle powder seasoning has received numerous accolades, including the 2017 FABI (Food and Beverage Industry) award from the National Restaurant Association.

18. Oprah Winfrey has endorsed TRUFFLE ZEST truffle powder seasoning extensively on her show, in her cookbook and by forming a co-promotion partnership between

Sabatino and Mealttime Stories, LLC, her joint venture with Kraft/Heinz, to promote Sabatino's TRUFFLE ZEST truffle powder seasoning.

19. A Google search for "TRUFFLE ZEST" displays the first five non-sponsored results for Sabatino's TRUFFLE ZEST truffle powder seasoning.

20. Approximately \$1,650,000 has been spent advertising TRUFFLE ZEST truffle powder seasoning.

21. TRUFFLE ZEST truffle powder seasoning has had sales of \$3,700,000, with projected sales of \$2,500,000 for 2019.

SABATINO'S TRADEMARK RIGHTS IN TRUFFLE ZEST

22. Sabatino has, since September 2015, conspicuously and continuously used the TRUFFLE ZEST Mark in interstate commerce in connection with truffle powder seasoning.

23. Sabatino is the owner of U.S. Trademark Registration No. 5,163,009 on the Supplemental Register dated March 14, 2017 for TRUFFLE ZEST for "Truffle powder seasoning".

24. Due to Sabatino's extensive use, sales and promotion of TRUFFLE ZEST truffle powder seasoning, and the recognition and widespread promotion that it has received, TRUFFLE ZEST for truffle powder seasoning has become associated with Sabatino in the minds of the consuming public, and has achieved secondary meaning.

25. Sabatino owns exclusive common law rights in the TRUFFLE ZEST mark for truffle powder seasoning.

DEFENDANTS' WRONGFUL CONDUCT

26. Tartufi Jimmy, rather than develop an innovative product or marketing strategy for its Truffle Spice, mimicked the distinctive trade dress of TRUFFLE ZEST truffle powder seasoning in an attempt to usurp Sabatino's hard-earned goodwill associated with TRUFFLE ZEST truffle powder seasoning, and confuse the consuming public.

27. As shown below, Tartufi Jimmy's Truffle Spice trade dress mimics several key elements of the unique and distinctive Sabatino's TRUFFLE ZEST truffle powder seasoning trade dress, including (1) a white label with negative lettering on a gold background; 2) a gold circle with similar negative lettering on a gold background; 3) the bottom of the label prominently featuring a large half-open truffle with black skin among other open truffles without black skin; and 4) the same shape and sized bottle. The overall impression conveyed by the new Truffle Spice trade dress is confusingly similar to that of TRUFFLE ZEST truffle powder seasoning:



See also <https://titaitalia.com/products/truffle-spice-seasoning>;
<https://www.jimmytartufi.it/prodotto/truffle-spice/>

28. In designing the Truffle Spice trade dress, Tartufi Jimmy radically deviated from the trade dress it used for its other products. For example, as shown below, Tartufi Jimmy's trade dress for its products typically features a white label, dark colored lettering, and a dark oval label bearing "Taruffi Jimmy" in lighter colored lettering.

<https://www.jimmytartufi.it/prodotto/gourmet-al-tartufo-bianco/>;

<https://www.jimmytartufi.it/prodotto/gourmet-al-tartufo-nero/>;

<https://www.jimmytartufi.it/prodotto/curry-al-tartufo-bianco/>.



29. Tartufi Jimmy also radically deviated from the trade dress it had been previously using for its Truffle Spice product. <https://www.jimmytartufi.it/prodotto/truffle-spice-condimento-con-tartufo-nero/>



30. Tartufi Jimmy's copying of Sabatino's TRUFFLE ZEST truffle powder seasoning trade dress appears to be one of Tartufi Jimmy's first products not to feature its oval "Tartufi Jimmy" logo prominently on its label. Instead, like Sabatino's TRUFFLE ZEST truffle powder seasoning trade dress, Tartufi Jimmy's new Truffle Spice trade dress has negative gold lettering, a circular gold design with more negative gold lettering, and an open truffle at the bottom of the label shaded almost exactly like Sabatino's TRUFFLE ZEST truffle powder seasoning.



31. The confluence of similarities between the Sabatino's TRUFFLE ZEST truffle powder seasoning trade dress and Tartufi Jimmy's Truffle Spice new trade dress simply cannot be coincidence, and instead powerfully suggests a bad faith intent to trade on Sabatino's hard-earned good will associated with TRUFFLE ZEST truffle powder seasoning.

32. Both Tartufi Jimmy and Tita Italian are selling Truffle Spice truffle powder seasoning to consumers in the United States including the State of New York through their respective websites.

33. Defendants unlawful conduct is likely to create consumer confusion, which will cause serious and irreparable harm to Sabatino. This conduct, if not enjoined, could eviscerate the goodwill Sabatino has spent years carefully cultivating for its brand.

LIKELIHOOD OF CONFUSION

34. Due to the striking similarity between Tartufi Jimmy's Truffle Spice and Sabatino's TRUFFLE ZEST truffle powder seasoning, there is a high likelihood that consumers will buy the Tartufi Jimmy product under the mistaken belief that it comes from, is manufactured by, sponsored by, or is associated or affiliated with, Sabatino.

35. The new Tartufi Jimmy Truffle Spice competes directly with Sabatino products in the exact same channels of commerce.

36. Tartufi Jimmy has adopted a trade dress for its Truffle Spice products that is likely to confuse consumers into thinking they are buying a product that comes from or is associated with Sabatino as the maker of TRUFFLE ZEST truffle powder seasoning, and Sabatino is being irreparably harmed by the confusion.

DEFENDANT TITA ITALIAN'S WRONGFUL CONDUCT

37. Defendant Tita Italian, on its facebook page, has caused confusion with Sabatino's TRUFFLE ZEST mark by using the hashtag #trufflezest on its facebook page on which it displays Tartufi Jimmy's Truffle Spice product, as shown below at <https://www.facebook.com/Titaitaliawine/>.



38. Given Sabatino's trademark rights in the mark TRUFFLE ZEST for truffle powder seasoning, the consuming public is likely to be confused into believing that there is some connection between Tita Italian or Tartufi Jimmy on the one hand, and Sabatino on the other, by Tita Italian's competitive use of the #trufflezest hashtag, a mark in which Sabatino owns exclusive common law trademark rights.

COUNT ONE

**Trade Dress Infringement, False Designation of Origin and Federal Unfair Competition
(15 U.S.C. § 1125(a)(1)(A))**

39. Sabatino repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

40. As noted above, the new Tartufi Jimmy Truffle Spice product features a label with trade dress that is confusingly similar to the Sabatino trade dress.

41. Tartufi Jimmy's act of trade dress infringement, and the sale of such infringing product by Tita Italian, unless restrained, will cause great and irreparable injury to Sabatino and to the business and goodwill represented by the Sabatino trade dress, in an amount that cannot be ascertained at this time, leaving Sabatino with no adequate remedy at law.

42. Tartufi Jimmy's and Tita Italian's deceptive marketing and sales practices in connection with its new Truffle products in their present packaging constitutes false designation of origin and infringement of the Sabatino trade dress in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

43. Furthermore, Tita Italian's use of the #trufflezest hashtag, a mark in which Sabatino has exclusive trademark rights as a result of acquired distinctiveness, on Tita Italian's facebook page is likely to deceive consumers into believing that there is some affiliation, connection or association between Tita Italian or Tartufi Jimmy's product, and Sabatino. Such unlawful competitive conduct by Tita Italian, unless restrained, will cause great and irreparable injury to Sabatino and to the business and goodwill represented by its TRUFFLE ZEST trademark.

44. Defendants deceptive conduct as described above was willful, and constitutes willful trade dress and trademark infringement.

45. By reason of the foregoing, Sabatino is entitled to injunctive relief against Defendants, restraining them from any further acts of trade dress infringement, false designation of origin and unfair competition, and, after trial, recovery of any damages (to the extent calculable) proven to have been caused by reason of Defendants' aforesaid acts.

COUNT TWO

(Trade Dress Infringement Under New York Law)

46. Sabatino repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

47. Defendants' acts, as described above, constitute trade dress infringement under N.Y. Gen. Bus. Law § 360-k.

COUNT FOUR

(Deceptive Acts and Practices Under New York Law)

48. Sabatino repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

49. The acts of Defendants as described above constitute deceptive acts and practices in violation of N.Y. Gen. Bus. Law § 349-50.

COUNT FIVE

(Unfair Competition under New York Law)

50. Sabatino repeats and realleges each and every allegation in the foregoing paragraphs as if fully set forth herein.

51. The acts of Defendants as described above constitute unfair competition in violation of Sabatino's rights under the New York State common law, as preserved by N.Y. Gen. Bus. Law § 360-o.

PRAYER FOR RELIEF

WHEREFORE, SABATINO respectfully prays:

A. That Defendants and all those in active concert or participation with it (including, but not limited to, its officers, directors, agents, servants, wholesalers, distributors, retailers, employees, representatives, attorneys, subsidiaries, related companies, successors, assigns and contracting parties) be temporarily, preliminarily and then permanently enjoined and restrained from:

i. manufacturing, distributing, shipping, advertising, marketing, promoting, selling or otherwise offering for the Tartufi Jimmy Truffle Spice product in the challenged trade dress or any other trade dress that is confusingly similar to that of Sabatino TRUFFLE ZEST truffle powder seasoning product or any of Sabatino's other products;

ii. representing, by any means whatsoever, that any products manufactured, distributed, advertised, offered or sold by Defendants are Sabatino's products or vice versa, and from otherwise acting in a way likely to cause confusion, mistake or deception on the part of purchasers or consumers as to the origin or sponsorship of such products;

iii) using the #trufflezest hashtag to market products competing with those of Sabatino; and

B. That Defendants and all those in active concert or participation with them (including, but not limited to, its officers, directors, agents, servants, wholesalers, distributors, retailers, employees, representatives, attorneys, subsidiaries, related companies, successors, assigns and contracting parties) take affirmative steps to dispel such false impressions that heretofore have been created by its use of the challenged trade dress, including, but not limited to,

recalling from any and all channels of distribution any and all infringing products and promotional materials.

C. That Defendants account to Sabatino for its profits and any damages sustained by Sabatino, to the extent calculable, arising from the foregoing acts of trade dress infringement, false designation of origin and deceptive acts and practices.

D. That, in accordance with such accounting, Sabatino be awarded judgment for three times such profits or damages (whichever is greater), pursuant to 15 U.S.C. § 1117 and N.Y. Gen. Bus. Law § 349(h).

E. That Sabatino have and recover its costs, including its reasonable attorneys' fees and disbursements in this action, pursuant to 15 U.S.C. § 1117 and N.Y. Gen. Bus. Law § 349(h).

F. That Sabatino be awarded punitive damages pursuant to the law of the State of New York in view of Defendants' intentional and willful trade dress and trademark infringement and other conduct.

G. That Defendants deliver up for destruction all infringing products in its possession or control and all means of making the same in accordance with 15 U.S.C. § 1118.

H. That Defendants file with the Court and serve on counsel for Sabatino within thirty (30) days after entry of any injunction issued by the Court in this action, a sworn written statement pursuant to 15 U.S.C. § 1116(a) setting forth in detail the manner and form in which Defendant has complied with any injunction which the Court may enter in this action.

I. That Sabatino have such other and further relief as the Court may deem just and proper.

JURY TRIAL DEMAND

Sabatino demands a trial by jury on all claims as to which a jury trial may be had.

Dated: New York, New York
June 10, 2019

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY & POPEO, P.C.

By: /Michael R. Graif/
Michael R. Graif
(MRGraif@mintz.com)
John A. Bauer
(JBauer@mintz.com)
666 Third Avenue
New York, New York 10017
(212) 692-6287 (telephone)
(212) 983-3115 (facsimile)

*Attorneys for Plaintiff SABATINO
NORTH AMERICA LLC, SABATINO
TRUFFLES NEW YORK, LLC AND
ETHOA, LLC*